

REMARKS

Claims 1 through 72 are pending in the application. Claims 1, 10, 19, 28, 37, 39, 50, 60 and 64 have been amended. Reconsideration of this application is respectfully requested.

Claims 1, 10, 19, 28, 39, 50 and 64 have been amended by changing "input means" to ---input device---.

The Office Action has objected to the drawing based on the contention that Fig. 16 does not correspond to the description in the paragraph beginning at page 16, line 3, as amended by the Amendment of October 14, 2003. The present Amendment amends this paragraph to clarify that if step 434 determines that a character palette has not been selected, step 436 sets a default character palette and if the character palette has been selected, step 434 records the selected character palette. It is submitted that this change clarifies any confusion concerning the correspondence between the description and Fig. 16 and, therefore, that this change obviates any need to change Fig. 16. Accordingly, it is submitted that the objection is inapplicable and should be withdrawn.

Subject to the approval of the Examiner, Fig. 13 of the drawing is amended as marked in red on the attached copy thereof by deleting the Y and N indications from box 350, which merely performs a wait and not a Yes/No determination.

*Approved
CPC
5/19/04*

The Office Action has objected to the specification based on reference legend 170 lacking any accompanying description. The present Amendment changes the paragraph beginning at page 10, line 26, by adding a sentence that explains the nature of reference numeral 170.

The Office Action has also objected to the specification based on a lack of description of how the program proceeds after box 360 in Fig. 13. Box 360 is adequately described in the last sentence of the paragraph beginning at page 14, line 10, as amended by the Amendment of October 14, 2003. The Office Action refers to box 360 as making a Yes/No inquiry. However, box 360 merely waits for the user to enter the label content as noted in the last sentence of this paragraph. Accordingly, it is submitted that the objection is mistaken and should be withdrawn.

The Office Action has further objected to the specification based on a lack of description of how the program proceeds if box 438 in Fig. 16 makes a No determination. The present Amendment changes the paragraph beginning at page 16, line 3, with an insertion that clarifies that step 442 responds to a Yes determination of step 438 or a completion of step 440 to wait for the actuation of the generate labels button 188. It is submitted that this change obviates the objection.

For the reasons set forth above, it is submitted that the objections to the specification are inapplicable and should be withdrawn.

The Office Action rejects claims 37 and 60 under the second paragraph of 35 U.S.C. 112 as indefinite. With respect to claim 37, the Office Action contends that the indefiniteness is caused by the parenthetical "(f)". Claim 37 has been amended by deleting the parenthetical (f). With respect to claim 60, the Office Action contends that the indefiniteness is caused by the term "fifth entry" since parent claim 50 recites only "first entry" and "second entry". Claim 60 has been amended by changing "fifth" to "third" so that the numbering sequence is in order.

For the reason set forth above, it is submitted that the rejection of claims 37 and 60 under the second paragraph of 35 U.S.C. 112 is obviated by the amendment and should be withdrawn.

The Office Action rejects claims 1 through 7, 9 through 16, 18 through 25, 27 through 60 and 70 through 72 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,718,784 to Drisko, hereafter Drisko.

This rejection is inapplicable to independent claims 1, 10 and 19, which recite that the plurality of labels is formed for a single job. Thus, the recital that at least one of the labels is unrelated in numerical sequence to any of the other labels of the plurality of labels is for a single job. This allows a user in a single job to string together in a single job separate and distinct labels for printing. This is in contrast to prior systems that required separate jobs for separate and distinct labels, such as Drisko and the ones described at pages 1 and 2 of the specification. Thus, the Examiner's contention that the user in Drisko may select previously defined labels or create custom labels is inapplicable to claims 1, 10 and 19 as amended since Drisko does not teach doing previously defined labels and custom labels in a single job. Accordingly, the rejection is inapplicable to claims 1, 10 and 19.

In Paragraph No. 8, the Office Action contends that one of ordinary skill in the art would have recognized that Drisko's labels is a single job. There is no support in Drisko for this contention. Therefore, the contention is untenable.

Moreover, Drisko does not teach a single job in which at least one of the labels is unrelated in the numerical sequence to the other labels in the sequence as recited in claims 1, 10 and 19. In Paragraph Nos. 6.1.3 and 8, the Office Action also contends that one of ordinary skill in the art would have recognized that this recitation is non-functional descriptive material, citing *In re Gulack*, 217 USPQ 401. This case involved a rejection under 35 U.S.C. 103 and, therefore, is inapplicable to a rejection under 35 U.S.C. 102. Therefore, the contention is untenable.

This rejection is erroneous with respect to independent claims 28, 39 and 40 because Drisko does not teach assigning a positional palette to a first one of the plurality of positions of the label as recited in these claims. In Paragraph No. 8, the Office Action contends that one of ordinary skill in the art would have recognized three functionalities of Drisko. However, the Examiner cites no support in Drisko for any such recognition. For example, where in Drisko does support occur for : "the overlapping of some text/color combinations would render the label unintelligible or unusable" and " the font size would govern positioning"? Notwithstanding the lack of support, none of the alleged recognitions has anything to do with the recitations in claims 28, 39 and 50 concerning the assigning of a first positional palette to a first one of the positions in a label.

In Paragraph No. 8, the Office Action also contends that one of ordinary skill in the art would have recognized that Drisko would inherently include the ability for the user to place the desired color/text in any desired location on the label. The Office Action cites no support in Drisko for this recognition of inherency. In fact, the very contention of inherency is an admission that Drisko does not teach the assigning of a positional palette. For this reason, the contention is untenable.

With respect to claims 2, 3, 4, 11, 12, 13, 40, 43, 44, 51, 54 and 55, the Examiner contends that Applicants have failed to define the exact nature of the positional palette. This contention is erroneous because Fig. 3 of the drawing clearly shows a positional palette and the accompanying description in the specification at page 7, lines 17-31 clearly describes the positional palette. In the described example, character positions 66, 68 and 70 of label 64 are selected to have positional palettes. Each of the selected positions may have the same or different positional palettes. Each label created with the selected positional palette will have the attributes assigned to the palette for character positions 66, 68 and 70 and will be the same regardless of the value of any alphabetic or numeric character appearing in the character position.

The Examiner further contends in view of his position, that one of ordinary skill in the art would know that it is common practice to set forth to the user various options...". This contention is irrelevant to a rejection under 35 U.S.C. 102(b) since the recitals of the claim must be taught by the reference itself. In the instant case, Drisko does not teach a positional palette or the ability of a user to designate a positional palette and define a palette of attributes therefore. For this reason, the rejection of claims 2, 3, 4, 11, 12, 13, 40, 43, 44, 51, 54 and 55 is erroneous.

Independent claim 70 recites the presenting of an ad hoc interface to a user to define by user entry a plurality of labels that are unrelated in alphanumeric content or color. Drisko does not teach an ad hoc interface. Therefore, Drisko lacks the presenting step.

Independent claim 72 recites the step of presenting an interface to a user that has the capability of defining by user entry a plurality of labels that have related alphanumeric content, unrelated alphanumeric content or both in a single job. Drisko does not teach this capability. Therefore, Drisko lacks the presenting step.

For the reasons set forth above, it is submitted that the rejection of claims 1 through 7, 9 through 16, 18 through 25, 27 through 60 and 70 through 72 under 35 U.S.C. 102(b) as anticipated by Drisko is erroneous and should be withdrawn.

The Office Action rejects claims 8, 17, 26 and 61 through 69 under 35 U.S.C 103(a) as unpatentable over Drisko as applied to claims 1 through 7, 9 through 16, 18 through 25 and 27 through 60 and further in view of obvious variations.

This rejection is erroneous for a number of reasons. First, Drisko lacks steps or elements recited in respective parent claims 1, 10 and 19 of claims 8, 17 and 26 as pointed out in the above discussion of the rejection of the parent claims under 35 U.S.C. 102(b). Since the elements or steps are lacking in Drisko and the variations noted in the Office Action do not supply them, a *prima facie* case has not been made for obviousness.

Second, the Examiner admits at Paragraph No. 7.1.1 that Drisko does not teach an ability of the user to make an entry that causes the bar code to have a rotational orientation. The Examiner then contends that despite not teaching the rotational orientation feature, the possibility thereof is not excluded and, therefore, would have been obvious. This is saying that a claim recitation that is lacking in a reference is obvious without citing any evidentiary support. This is tantamount to grabbing an obvious variation out of thin air. If the rotational feature is obvious, evidentiary support must be found and made of record. Without any supporting evidence, the contention has no probative value. Therefore, no *prima facie* case has been made.

With respect to the aforementioned Gulack case, it is noted that the recitation in claim 1 that "at least one of the labels in a single job is unrelated in numerical sequence to any of the other labels of said plurality of labels" does not qualify as non-functional descriptive material. That one of the labels is unrelated to the others in numeric sequence is quite functional in distinguishing that a single job can accommodate both. In Drisko, a single job cannot accommodate both. It is to be noted that Gulack held that the printed matter in issue was indeed a functional limitation that had to be considered in the context of the claim as a whole.

This rejection is also erroneous as to claims 61 through 69. The Office Action states that the rejection is as applied to claims 1 through 7, 9 through 16, 18 through 25 and 27 through 60. This does not apply to claims 61 through 69,

because independent claim 61 and its dependent claims 62 through 69 are separate and distinct from the claims 1 through 7, 9 through 16, 18 through 25 and 27 through 60.

The Examiner contends that Drisko teaches to keep track of the number of labels printed. Drisko's only teaching concerning the number of labels printed appears at step 66 of Fig. 6. The specification at column 8, lines 49 and 50, states that "the user specifies the quantity of each label design to be printed, and the printing mode box 66." This teaching merely tells the computer how many labels the user wants to print. Drisko contains no teaching of the recitals in claim 61 for managing an inventory of label stock by keeping a current count of labels in the inventory and a warning count, presenting an alert to the user when the current count is less than the warning count and adjusting the current count with a number of refill labels received in response to an entry by the user and adjusting the current count as labels of the inventory are used.

Also, the Examiner, relying on the unsupported statement discussed above, leaps to a conclusion that it would have been obvious to modify Drisko to provide alterable alert levels. Neither the statement nor Drisko teaches alterable alert levels. For the reason set forth above, a *prima facie* case of obviousness has not been made with respect to claims 61 through 69.

In Paragraph No. 8.3, the Examiner makes a statement that since Applicants have not shown that one of ordinary skill would have had the knowledge of the so-called obvious variants, applicants' arguments are non-persuasive. This statement is traversed. The burden is on the Examiner, not the Applicants, to cite evidence that supports a *prima facie* case of obviousness. For the reasons set forth above, the Examiner has not met this burden.

The Office Action provides no motivation for one skilled in the art to use the variations noted in the Office Action and discussed above. The Office Action

suggestion to seek and/or use these variations in combination with Drisko is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reason set forth above, it is submitted that the rejection of claims 8, 17, 26 and 61 through 69 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

It is respectfully requested for the reasons set forth above that the objections to the drawing and specification be withdrawn, that the rejections under 35 U.S.C. 112, 35 U.S.C. 102(b) and 35 U.S.C. 103(a) be withdrawn, that claims 1 through 72 be allowed and that this application be passed to issue.

Respectfully Submitted,

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